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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,764	07/27/2001	Karl-Anton Starz	33766W036	7470
7590	10/20/2004		EXAMINER	
KALOW & SPRINGUT LLP 488 MADISON AVENUE 19TH FLOOR NEW YORK, NY 10022			WILLS, MONIQUE M	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/915,764	STARZ ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Monique M Wills	1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 August 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

***Response to Amendment***

This Office Action is responsive to the Amendment filed August 5, 2004.

The following rejections are overcome:

- Claims 1-7 under 35 U.S.C. §102(e) as being anticipated by Mizuno et al., U.S. Publication 2001/0024748.
- Claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Mizuno et al., U.S. Publication 2001/0024748 in view of Binder et al., U.S. Pub. 2002/0037449.

The instant claims are newly rejected as follows:

- Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer DE 196 11 510 in view of Goller et al., U.S. Patent 4,185,131.
- Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer DE 196 11 510 in view of Goller et al., U.S. Patent 4,185,131 and further in view of Binder et al., U.S. Pub. 2002/0037449.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer DE 196 11 510 in view of Goller et al., U.S. Patent 4,185,131.

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With respect to claim 1, Fischer teaches an ink for producing a membrane electrode assembly for a fuel cell comprising 3.1wt% Pt/C catalyst, 30.9wt% of a 5% strength ionomer solution in 90 parts isopropanol and 10 parts water, 37.2 wt% glycerine, 24.8wt % water, 2.5 wt% tetrabutylammonium hydroxide and 1.5 wt% of a pore former. The water content of the ink is 27.7 wt% in total. See Applicant's instant disclosure bridging pages 2 & 3. In re claims 6-7, the polymer electrolyte membrane is coated with the ink in accordance with the screen printing process on page 3 of the instant disclosure.

Fischer is silent to: containing a linear dialcohol with a flash point higher than 100°C and being present in the ink in a concentration between 1 and 50 wt%, with respect to the weight of water (claims 1 & 2); the linear alcohol being a dihydric alcohol wherein hydroxyl groups are not adjacent to each other (claim 3); an alcohol chain structure that is aliphate-CH<sub>2</sub> groups, optionally with oxygen atoms between said CH<sub>2</sub> groups (claim 4); or a dialcohol selected from the group consisting of ethylene glycol, diethylene glycol, propylene glycol, dipropylene glycol or butanediol (claim 5).

However, Goller teaches the functional equivalence of glycerin and ethylene glycol as organic solvent inking vehicles for fuel cell constituents (col. 5, lines 5-20).

Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the instant invention was made because even though Fischer does not teach ethylene glycol, Goller teaches that ethylene glycol and glycerine are art recognized equivalent materials for use as organic solvent inking vehicles, and therefore one having ordinary skill in the art would have substituted one organic solvent for the other.

In re claim 1, it is reasonable to expect that the ethylene glycol of Goller is a linear dialcohol with a flash point higher than 100°C, because Fischer in view of Goller employ the same organic solvent as the instant claims. Additionally, "products of identical chemical

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composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 2d 1655, 1658.

As to the limitation in claims 1 & 2, with regard to the organic solvent being present between 1 and 50-wt% by weight of water, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ said water concentration, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CPA 1980). The skilled artisan recognizes that the amount of water directly effects the dispersion ability of the ionomer in the ink.

In re claims 3 & 4, according to the instant disclosure bridging pages 4 & 5, ethylene glycol is a dihydric alcohol with hydroxyl groups not adjacent to each other with a chain structure that is aliphate-CH<sub>2</sub> groups. Additionally, “products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 2d 1655, 1658.

*Claim Rejections ~ 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer DE 196 11 510 in view of Goller et al., U.S. Patent 4,185,131 and further in view of Binder et al., U.S. Pub. 2002/0037449.

Fischer in view of Goller teaches an ink coated on a membrane electrode assembly as described hereinabove.

Fischer is silent to a gas distributor substrate coated with the ink.

Binder teaches that it is conventional to coat ink catalyst on gas distributor layers in order to form membrane electrode units.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to coat the catalyst ink of Fischer on a gas distributor layer, because Binder teaches that it is well known to employ ink catalyst coating on gas distributor layers in fuel cells.

#### *Response to Arguments*

Applicant's arguments, see pages 1~2, filed August 5, 2004, with respect to the rejection claims 1~7 under 35 U.S.C. §102(e) as anticipated by Mizuno et al., U.S. Publication 2001/0024748 have been fully considered and are persuasive. The instant rejection has been withdrawn.

Applicant's arguments, see pages 1-3, filed August 5, 2004, with respect to the rejection of claim 8 under 35 U.S.C. § 103(a) as unpatentable over Mizuno et al., U.S. Publication 2001/0024748 in view of Binder et al., U.S. Pub. 2002/0037449 have been fully considered and are persuasive. The instant rejection has been withdrawn.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

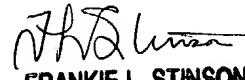
If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Barr, may be reached at 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MW

10/17/04

  
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